

REMARKS

Reconsideration of the application is respectfully requested.

Claims 1, 4, 6-9, 11 and 15-20 are in the application. Claims 15-20 presently stand withdrawn in view of a previous election.

I. Claims 1, 4, 8, 9, and 11

In the Official Action, the Examiner rejected claims 1, 4, 8, 9 and 11 under 35 U.S.C. §103(a) as being allegedly unpatentable over Mussi (EP 0 614 967) in view of Land (U.S. Patent No. 3,630,849), further in view of Weick et al. (U.S. Patent No. 5,908,127) and further in view of Kayal et al. (U.S. Patent No. 5,695,987).

For the various reasons noted below, it is respectfully submitted that claims 1, 4, 8, 9 and 11 are patentable over these cited references.

A. Land and Weick et al. Are Nonanalogous Art

As indicated in MPEP §2141.01(a), and acknowledged by the Examiner in the Official Action, only references that relate to the field of an inventor's endeavor or that are reasonably pertinent to the particular problem to which an inventor is concerned with may be relied upon in formulating a rejection. Land and Weick et al. are outside the inventor's field of endeavor and are not at all concerned with the particular problems with which the inventor herein was concerned.

The inventor herein, as set forth in the "Field of the Invention" section of the subject specification, was concerned with providing "a roller bottle having a recess portion at its bottom end for accommodating an adjacently stacked roller bottle in a manner which allows gases to enter a gas-permeable cap of the stacked bottles." As discussed at para. [0007], of the application as published, vented caps tend to undesirably seal with roller bottles arranged in a stacked relationship. The sealing prevents gas flow in and out of the roller bottles.

Land is directed to a receptacle and lid combination for molding solidified nutrient containing agar-agar. (Abstract). Figs. 1 and 2 depict a receptacle 10 and lid 12 combination. As for Weick et al., Weick et al. is directed to a load bearing polymeric container. The container includes a plurality of convex dimples 52 which "assist in uniformly distributing stresses and strains, both during hot-filing and cooling and during storage, transportation, display and use." (Col. 6, ll. 34-40).

It is clear that the inventor herein seeking to satisfy the problems associated with inadvertent sealing of vented caps on roller bottles would not look to Land or Weick et al. Land is concerned with providing a sealed container while Weick et al. does not even provide any disclosure for a cap construction.

In the Official Action, the Examiner asserted that "Mussi and Land are analogous art because they are from the same field of endeavor regarding cell culture devices." The Examiner further asserted that "Mussi and Weick are analogous art because they are from the same field of endeavor regarding bottle construction." The Examiner's assertions are respectfully traversed. Analogous art is not determined by comparing prior art references, but rather comparing prior art references against a claimed invention. As set forth above, the Applicant's field of endeavor is with roller bottles. As such, Mussi and Kayal et al. are admittedly analogous art. However, Land and Weick et al. are not.

It is critical to define the problem confronting an inventor in establishing whether or not a reference is analogous prior art. In the Official Action, the Examiner set forth two completely different bases for claiming prior art is analogous. With respect to Land, the Examiner referred to "cell culture devices", while with respect to Weick et al., the Examiner referred to "bottle construction". As indicated by the Board, "[p]recise definition of the problem is important in determining whether a reference is from a nonanalogous art. Defining the problem too narrowly may result in excluding consideration of relevant prior art. By the same token, defining the problem too broadly, as done here, may result in considering prior art as 'analogous' which is inconsistent with real world considerations." *Ex parte Dussaud*, 7 U.S.P.Q.2d 1818, 1819

(B.P.A.I. 1988) (citation omitted). No precise definition has been provided here. Rather, generic references to two different categories of devices has been made.

In the case of *In re Oetiker*, the Court found that all hooking problems are not analogous and that a hook for garments is not analogous to a hook for use with hose clamps. 24 U.S.P.Q.2d 1143, 1145-46 (Fed. Cir. 1992). As in *In re Oetiker*, not every device is analogous to the claims of the subject invention. These claims are in the field of roller bottle design. With the specific problem of inadvertent sealing of vented caps, one skilled in the art would not look to Land or Weick et al. For all the reasons stated above, it is respectfully submitted that Land and Weick et al. are not analogous art and can not be properly relied upon in formulating any rejection herein.

B. Impermissible Hindsight Reconstruction

Even assuming *arguendo* that Land and Weick et al. are analogous art, it appears that the Examiner utilized impermissible hindsight reconstruction in formulating the rejection.

Mussi is directed to a roller bottle assembly which includes a central concave portion 42 sized to partially accommodate the cap and neck portion of an adjacent bottle assembly. (P. 3, ll. 57-58). As noted by the Examiner, the planar surface therein is smooth. The Mussi roller bottle assembly also includes a cap 36 for mounting onto the assembly. (P. 3, ll. 48-51). As shown in the figures (e.g., Figs. 1 and 5), the cap 36 has a solid top portion. As noted at p. 3, ll. 49-51, it is preferred that the cap 36 and the neck 32 of the bottle be threaded so that the cap 36 may be left partially opened to allow exchange of gases between the interior and exterior of the bottle assembly. There is no disclosure in Mussi to have gas transmitted through the top portion of the cap 36.

As the Board has stated,

...we note that it is impermissible to use the claimed invention as an instruction manual or "template" to piece together isolated disclosures and teachings of the prior art so that the claimed invention may be rendered obvious. We additionally note that a rejection based on Section 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the

prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection he advances. He may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in the factual basis.

Ex parte Haymond, 41 U.S.P.Q.2d 1217, 1220 (B.P.A.I. 1996) (citation omitted).

In formulating the rejection, the Examiner selectively chose aspects of four references in formulating the rejection. It must be noted, that as set forth above, Mussi does not utilize a vented cap. Claim 1 expressly covers a vented cap. Moreover, as set forth above, the subject invention is directed to the inadvertent sealing of vented caps. Even if it is asserted that it would have been obvious to provide a vented cap to Mussi, Mussi provides a solution for inadvertent sealing, by disclosing partial threading of the cap. Thus, rather than seeking to define an air space, as set forth in the claims, Mussi provides a completely different solution, one of which involves venting between the threads of the neck of the container and the cap and out of the cap. Only with hindsight reconstruction based on Applicant's claims can the Examiner arrive at the proposed hypothetical combination.

Furthermore, the convex dimples 52 of Weick et al. cited by the Examiner are not disclosed for stacking purposes, but are cited for reinforcement. (Col. 6, ll. 36-40). It is completely unclear how one skilled in the art would look to Weick et al. to redesign Land and Mussi particularly for creating vent passages. It is respectfully submitted that because the hypothetical combination of Mussi, Land, Weick et al. and Kayal et al. is based on impermissible hindsight reconstruction, this rejection should be withdrawn.

C. Hypothetical Combination Does Not Yield Claimed Invention

Even taking the hypothetical combination proposed by the Examiner, the claimed invention is not obtained. In particular, the hypothetical combination does not provide each of the claimed limitations and, as such, does not provide a *prima facie* showing of obviousness.

Claim 1 discloses not only “a space between said open orifice of said cap and said planar surface”, but also that “said side wall being configured to define a gap between said side wall and said cap, said gap being in communication with said space”. Because Mussi has no concern with venting a cap accommodated in the central concave portion 42, there is no disclosure or suggestion in Mussi of forming a gap about an accommodated cap. Without any concern for such venting, there is no basis for modifying Mussi. It is respectfully submitted that claims 1, 4, 8, 9 and 11 are patentable over Mussi, Land, Weick et al. and Kayal et al., each taken alone or in combination.

II. Claims 6 and 7

In the Official Action, the Examiner rejected claims 6 and 7 under 35 U.S.C. §103(a) as being allegedly unpatentable over Mussi in view of Land, further in view of Weick et al., further in view of Kayal et al., and further in view of Pedmo (U.S. Patent No. 6,585,123). The Examiner relied on Pedmo for the alleged notion of “a plurality of equally spaced part, outwardly radiating ribs in the roller bottle assembly”. The Examiner asserted that Pedmo is analogous art because “Mussi and Pedmo are analogous art because they are from the same field of endeavor regarding the use of capped bottles to contain a fluid.”

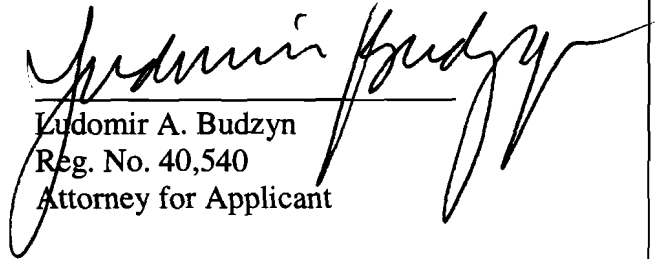
For the reasons set forth above, particularly with respect to Weick et al., it is respectfully submitted that Pedmo is not analogous art. It is noted that the Examiner here provides a third field of endeavor, different from the fields defined for Land and Weick et al. Moreover, Pedmo does not overcome the deficiencies noted above of Mussi, Land, Weick et al. and Kayal et al. It is respectfully submitted that claims 6 and 7, as depending from claim 1, are also patentable.

Applicant: Kenneth W. Whitley
Application No.: 10/666,157
Filing Date: September 19, 2003
Page 7 of 7

III. Conclusion

Favorable action is earnestly solicited. If there are any questions or if additional information is required, the Examiner is respectfully requested to contact Applicant's attorney at the number listed below.

Respectfully submitted,



Ludomir A. Budzyn
Reg. No. 40,540
Attorney for Applicant

HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791
(973) 331-1700